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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/507,191 | 02/18/2000 | Paul England | MS1-408US | 8393 |

| | | | EXAMINER |
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| 22801 | 7590 | 04/15/2004 | COLIN, CARL G |

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| ART UNIT | PAPER NUMBER |
|---|---|
| 2136 | |

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| Office Action Summary | Application No. | Applicant(s) |
|---|---|---|
| | 09/507,191 | ENGLAND, PAUL |
| | Examiner | Art Unit |
| | Carl Colin | 2136 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on _22 January 2004_ .

2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) _1-42_ is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-42_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on _18 February 2000_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

　　If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All  b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____ .

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

　　a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

# DETAILED ACTION

## *Response to Arguments*

1.     In response to communications filed on 1/22/2004, Applicant adds claim 39-42, the

following **claims 1-42** are presented for examination.

2.     Applicant's arguments, see pages 11-17, filed on 1/22/2004, with respect to the rejection

of claims 1-38, under 35 USC 102 (e) have been fully considered and are persuasive.  Bharat and

Ansell teach the limitations of claims 1-38, but do not explicitly teach randomly retrieving data.

Therefore, the rejection has been withdrawn.  However, upon further consideration, a new

ground of rejection is made in view of Herzberg et al. in combination with the teaching of

Ansell.  Herzberg et al. teaches a method and system for detecting authorized program by

random selection of data block, data, and identifier and perform verification to determine if data

is valid.  Regarding the dependent claims, the teaching of Bharat and Ansell in the first Office

Action still applies as far as disclosing other limitations not challenged by Applicant.

## *Claim Objections*

3.     Claim 39 and the intervening claims are objected because of the following informalities:

the term "substantially" should be corrected to avoid rendering the claim indefinite.  See MPEP

§ 2173.05(b).

## *Claim Rejections - 35 USC § 103*

4.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or
>
> described as set forth in section 102 of this title, if the differences between the subject
>
> matter sought to be patented and the prior art are such that the subject matter as a whole
>
> would have been obvious at the time the invention was made to a person having ordinary
>
> skill in the art to which said subject matter pertains.  Patentability shall not be negatived
>
> by the manner in which the invention was made.

4.1     **Claims 1-42** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent

6,367,019 to **Ansell et al.** in view of US Patent 5,745,678 to **Herzberg et al.**.

4.2     **As per claims 1, 23, 24, 30, and 38, Ansell et al.** substantially discloses a method

comprising: retrieving data from a removable data storage medium (see claims 44-48), wherein

the removable data storage medium contains an executable application program (see column 2,

lines 5-14); comparing the retrieved data to corresponding verification data, wherein the

verification data is known to be valid (see claims 44-48); and allowing execution of the

executable application program if the retrieved data matches the corresponding verification data

(see column 2, lines 28-35).  **Ansell et al.** does not explicitly teach _randomly_ retrieving data.

However, **Herzberg et al.** in an analogous art teaches _randomly_ retrieving data to determine if

data is valid, for example (see column 2, lines 4-36 and column 5, lines 58 through column 6).  It

would have been obvious to one of ordinary skill in the art at the time the invention was made to

modify the method of **Ansell et al.** to randomly retrieving data as taught by **Herzberg et al.** in

order to more efficiently validate the multimedia program (see column 6, lines 18-34). This

modification would have been obvious because one of an ordinary skill in the art would have

been motivated by the suggestion provided by **Herzberg et al.** so as to more efficiently validate

the multimedia program.

**Claim 10** is similar to claim 1. **Ansell et al.** discloses a method comprising: randomly

retrieving data from a removable data storage medium (see claims 44-48), wherein the

removable data storage medium contains at least one file of audio data (see column 2, lines 5-

14); comparing the retrieved data to corresponding verification data, wherein the verification

data is known to be valid (see claims 44-48); and allowing execution of the at least one file of

audio data if the retrieved data matches the corresponding verification data (see column 2, lines

28-35 and column 5, lines 32-46).

**Claim 17** is similar to the rejected claim 1 except for stating data block instead of data.

**Herzberg et al.** teaches randomly retrieving at least one data block from the removable data

storage medium, wherein the removable data storage medium contains a plurality of data blocks

and verifying and validating data block, for example (see column 8, lines 40-67 and column 6,

lines 25 et seq. and column 15, lines 14-30). Therefore **claim 17** is rejected on the same

rationale as the rejection of **claim 1**.

**As per claims 34 and 35, Herzberg et al.** substantially discloses a method comprising:

randomly selecting a data block identifier, wherein the data block identifier identifies a particular

data block on a removable data storage medium in different embodiments, for example (see

column 11, lines 9-12 and column 8, lines 40-50 and lines 10-24); issuing a challenge and the

data block identifier to a data reading device, wherein the removable data storage medium is

readable by the data reading device, for example (see column 8, lines 45-67 and column 10, lines

24-67); hashing the challenge with the data contained in the particular data block on the

removable data storage medium (see column 8, lines 45-67 and column 10, lines 24-67);

receiving the result of the hashing operation medium, for example (see column 8, lines 45-67 and

column 10, lines 37-67);comparing the result of the hashing operation to corresponding

verification data, wherein the verification data is known to be valid, for example (see column 8,

lines 45-67 and column 10, lines 37-67); and determining that the removable data storage

medium is legitimate if the result of the hashing operation matches the corresponding

verification data, for example (see column 8, lines 45-67 and column 10, lines 37-67). To one

skilled in the art it is apparent that the limitations of claim 34 are disclosed by **Herzberg et al.**.


     **Claims 39 and 40** are similar to the rejected claim 17 except for performing a

cryptographic operation and obtain a digest. **Herzberg et al.** teaches randomly retrieving at least

one data block from the removable data storage medium, and performing cryptographic

operation to obtain a first and second digest to match, for example (see column 8, lines 40-67

and column 12, lines 20-67, and column 15, lines 14-30). Therefore **claims 39 and 40** are

rejected on the same rationale as the rejection of **claim 17**.

As per claim 41, **Herzberg et al.** discloses performing secure hash algorithm, for example (see column 10, lines 21-26).

As per claim 42, **Herzberg et al.** discloses second digest is stored in a different medium than the one the data blocks are stored, for example (see column 8, lines 40-67 and column 12, lines 20-67, and column 15, lines 14-30).

As per claims 2, 11, and 31, **Ansell et al.** discloses the limitation of further including preventing execution of the executable application program and at least one file of audio data if the retrieved data does not match the corresponding verification data (see column 2, lines 5-14).

As per claim 3, **Ansell et al.** discloses the limitation of wherein the executable application program is executed from the removable data storage medium (see column 2, lines 5-14).

As per claim 4, **Ansell et al.** discloses the limitation of wherein the executable application program is executed from the removable data storage medium (column 2, lines 28-51).

As per claims 5, 12, 19, 26, 32, and 36, **Ansell et al.** discloses the limitation of wherein the removable data storage medium is a compact disc (CD) (see column 5, lines 20-25).

As per claims 6, 13, 20, 27, 33, and 37, **Ansell et al.** discloses the limitation of wherein the removable data storage medium is a digital versatile disc (DVD) (see column 5, lines 20-25).

As per claim 7, **Ansell et al.** discloses the limitation of further including partitioning the removable data storage medium into a plurality of data blocks (column 5, line 47 through column 6).

As per claim 8, **Ansell et al.** discloses the limitation of further including: partitioning the removable data storage medium into a plurality of data blocks; and calculating a cryptographic digest for each of the plurality of data blocks (column 5, line 47 through column 7).

**Claims 9 and 16** have the same limitation as **claim 1** except for incorporating the claimed method into a computer-readable medium containing a program to perform the steps of claim 1. Therefore, **claims 9 and 16** are rejected on the same rationale as the rejection of **claim 1**.

As per claim 14, **Ansell et al.** discloses the limitation of wherein allowing access to the at least one file of audio data includes installing the at least one file of audio data to a handheld audio player (column 5, lines 19-46).

As per **claim 15**, **Ansell et al.** discloses the limitation of wherein allowing access to the at least one file of audio data includes playing the at least one file of audio data to a handheld audio player (column 5, lines 19-46).

As per **claims 18 and 25**, **Herzberg et al.** discloses the limitation of further including determining that a legitimate removable data storage medium is not present if the retrieved data block does not match the corresponding verification data block (see column 8, lines 40-67).

As per **claim 21**, **Herzberg et al.** discloses the limitation of calculating a cryptographic digest for each retrieved data block, wherein the verification data block has an associated cryptographic digest, for example (see column 8, lines 40-67 and column 6, lines 25 et seq. and column 15, lines 14-30).

As per **claim 22**, **Herzberg et al.** discloses the limitation of wherein comparing the retrieved data block to a corresponding verification data block comprises comparing the cryptographic digest of the retrieved data block with the cryptographic digest associated with the verification data block, for example (see column 8, lines 40-67 and column 6, lines 25 et seq. and column 15, lines 14-30).

As per **claim 28**, **Ansell et al.** discloses the limitation of wherein the verification module and the data reading device are coupled to one another across the Internet (column 4, lines 55-67).

**As per claim 29, Ansell et al.** discloses the limitation of wherein the verification module is located in a handheld audio player and the data reading device is located in a computer system coupled to the handheld audio player (see column 4 and figure 1).

## *Conclusion*

5.      Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 703-305-0355. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9595. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.


Carl Colin

Patent Examiner

April 12, 2004

AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100